



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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TECH CENTER 2000

In re Patent Application of:  
Pong et al.

Confirmation No. 9580

Application No.: 10/017,661

Group Art Unit: 2821

Filed: December 14, 2001

Examiner: D.A. Minh

For: HIGH EFFICIENCY DRIVER FOR  
COLOR LIGHT EMITTING DIODES  
(LED)

Attorney Docket No.: V9661.0024

Date: June 30, 2004

DECLARATION OF MAN HAY PONG UNDER 37 C.F.R. § 1.131

Dear Sir:

I, Man Hay Pong, do hereby declare and state as follows:

1. I reside at Flat G, 1st Floor, Tower 13A, Yee Fai Court, Couth Horizons, ApLeiChau, Hong Kong, China.
2. I am one of the co-inventors (Franki Ngai Kit Poon and Joe Chul Pong Liu) of the above-identified U.S. patent application (the " '661 application") filed on December 14, 2001, as evidenced by the attached executed Declaration (Exhibit A, attached hereto) filed with the '661 application.
3. I have reviewed and understand the '661 application, including the currently pending claims, including any and all amendments (the "Claimed Invention").
4. We conceived the invention covered by the Claimed Invention prior to June 21, 2001, as evidenced by Exhibit B (attached hereto), which is a written record of a meeting among the inventors (the "Meeting Record"). The Meeting Record contains a disclosure of the conception of the Claimed Invention. The actual date on this document and any description not relevant to the conception of the Claimed Invention have been redacted. Nevertheless, the actual date of this Inventor Record predates June 21, 2001. Therefore, the very existence of

**Application No. 10/017,661**

**Docket No.: V9661.0024**

the Meeting Record establishes not only our conception of the Claimed Invention but also the due diligence prior to June 21, 2001.

5. The former law firm of Pennie & Edmonds LLP ("P&E") was assigned to write this application, as evidenced by attached Exhibit C, which is a copy of the September 11, 2001 order letter to P&E from Versitech Ltd., the University Technology Transfer Company.

6. P&E began drafting the '661 application covering the Claimed Invention, and completed the draft of the '661 application on October 3, 2001. Attached as Exhibit D is a copy of an email correspondence from P&E to Versitech forwarding the draft for inventors' comments.

7. After I reviewed the draft application, I provided comments on the draft and forwarded my comments to Versitech Ltd. on November 1, 2001 as shown in Exhibit D.

6. We then worked with the P&E to finalize the draft and complete the '661 application for filing. Attached as Exhibit E is a copy of the November 29, 2001 fax-letter to Versitech Ltd. from P&E forwarding (i) Declaration for Non-Provisional Patent Application; (ii) Assignment; and (iii) Power of Attorney by Assignee to Versitech Ltd. for the inventors' and the assignee's signatures.

7. The inventors executed the '661 application covering the Claimed Invention on December 10, 2001, as evidenced by the Declaration (Exhibit A). We also assigned the rights to the Claimed Invention to The University of Hong Kong on December 10, 2001, as evidenced Exhibit F which is a copy of the Assignment. Attached as Exhibit G is a copy of December 12 letter from Versitech Ltd. forwarding the signed Declaration and Assignment to P&E.

8. The '661 application was filed with the United States Patent and Trademark Office on December 14, 2001. The preparation of the present application covering the

Application No. 10/017,661

Docket No.: V9661.0024

Claimed Invention was thus diligently pursued from prior to June 21, 2001 to the date of filing, December 14, 2001.

9. The attached Exhibits are photocopies of original drawings, records, and other original evidence of my conception and reduction to practice of the Claimed Invention.

All statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful and false statements may jeopardize the validity of the above-identified patent.

Date: June 30, 2004By: Man Hay Pong

**DECLARATION FOR NON-PROVISIONAL PATENT APPLICATION\***

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below at 201 et seq. beneath my name.

I believe I am the original, first and sole inventor if only one name is listed at 201 below, or an original, first and joint inventor if plural names are listed at 201 et seq. below, of the subject matter which is claimed and for which a patent is sought on the invention entitled

**HIGH EFFICIENCY DRIVER FOR COLOR LIGHT EMITTING DIODES (LED)**

and for which a patent application:

- ☒ is attached hereto and includes amendment(s) filed on *(if applicable)*  
☐ was filed in the United States on as Application No. *(for declaration not accompanying application)*  
 with amendment(s) filed on *(if applicable)*  
☐ was filed as PCT international Application No. on and was amended under PCT Article 19 on *(if applicable)*

I hereby state that I have reviewed and understand the contents of the above identified application, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations, §1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, §119(a)-(d) of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

EARLIEST FOREIGN APPLICATION(S), IF ANY, FILED PRIOR TO THE FILING DATE OF THE APPLICATION			
APPLICATION NUMBER	COUNTRY	DATE OF FILING (day, month, year)	PRIORITY CLAIMED
			YES <input type="checkbox"/> NO <input type="checkbox"/>
			YES <input type="checkbox"/> NO <input type="checkbox"/>
			YES <input type="checkbox"/> NO <input type="checkbox"/>

I hereby claim the benefit under Title 35, United States Code, §119(e) of any United States provisional application(s) listed below.


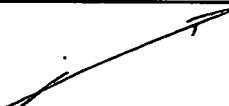
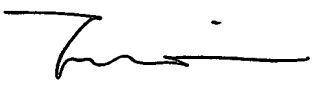
PROVISIONAL APPLICATION NUMBER	FILING DATE

I hereby claim the benefit under Title 35, United States Code, §120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code §112, I acknowledge the duty to disclose information known to me which is material to patentability as defined in Title 37, Code of Federal Regulations, §1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application:

NON-PROVISIONAL APPLICATION SERIAL NO.	FILING DATE	STATUS		
		PATENTED	PENDING	ABANDONED

\* for use only when the application is assigned to a company, partnership or other organization.

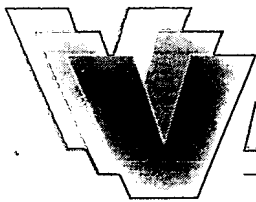
I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

201	FULL NAME OF INVENTOR	LAST NAME PONG	FIRST NAME Man Hay	MIDDLE NAME	
	RESIDENCE & CITIZENSHIP	CITY Hong Kong	STATE OR FOREIGN COUNTRY China	COUNTRY OF CITIZENSHIP China	
	POST OFFICE ADDRESS	STREET Flat G, 1 <sup>st</sup> Floor, Tower 13A, Yee Fai Court, South Horizons, ApLeiChau	CITY Hong Kong	STATE OR COUNTRY China	ZIP CODE
	SIGNATURE OF INVENTOR 201 			DATE 10 Dec 2001	
202	FULL NAME OF INVENTOR	LAST NAME POON	FIRST NAME Franki	MIDDLE NAME Ngai Kit	
	RESIDENCE & CITIZENSHIP	CITY Hong Kong	STATE OR FOREIGN COUNTRY China	COUNTRY OF CITIZENSHIP China	
	POST OFFICE ADDRESS	STREET 1 <sup>st</sup> Floor, 312, Ki Lung Street, Shan Shui Po, Kowloon	CITY Hong Kong	STATE OR COUNTRY China	ZIP CODE
	SIGNATURE OF INVENTOR 202 			DATE 10 Dec 2001	
203	FULL NAME OF INVENTOR	LAST NAME LIU	FIRST NAME Joe	MIDDLE NAME Chui Pong	
	RESIDENCE & CITIZENSHIP	CITY Hong Kong	STATE OR FOREIGN COUNTRY China	COUNTRY OF CITIZENSHIP China	
	POST OFFICE ADDRESS	STREET Flat 3406, Kwai Fung House, Kwai Chung, NT	CITY Hong Kong	STATE OR COUNTRY China	ZIP CODE
	SIGNATURE OF INVENTOR 203 			DATE 10 Dec 2001	
204	FULL NAME OF INVENTOR	LAST NAME	FIRST NAME	MIDDLE NAME	
	RESIDENCE & CITIZENSHIP	CITY	STATE OR FOREIGN COUNTRY	COUNTRY OF CITIZENSHIP	
	POST OFFICE ADDRESS	STREET	CITY	STATE OR COUNTRY	ZIP CODE
	SIGNATURE OF INVENTOR 204			DATE	
205	FULL NAME OF INVENTOR				
	RESIDENCE & CITIZENSHIP				
	POST OFFICE ADDRESS				

Discussion points



1. LED replace output diode in a flyback converter.
2. Converter must operate in discontinuous mode.
3. Output is short circuited.
4. fixed duty cycle control to control output power
5. PFC effect is inherent
6. HF at output may introduce EMI problem.



**VERSITECH LTD.**

The University technology transfer company

Ex. C

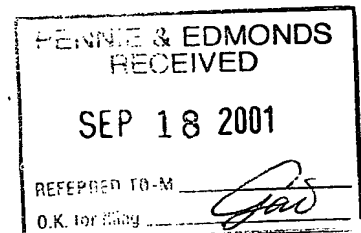


Our Ref.: IP00061

Your Ref.: --

11 September 2001

Ms. Hua Gao  
Pennie & Edmonds LLP  
1155 Avenue of the Americas  
New York, NY 10036-2711  
U.S.A.



Dear Hua,

Re: U.S. Regular Patent Application – High Efficiency driver for color  
Light Emitting Diodes (LED)

I refer to the above and would like to ask for your help to file the subject U.S. regular patent application.

Enclosed please find a hard copy and a soft copy of the draft invention document for your action.

Thank you for your assistance in this matter. I look forward to hearing from you soon.

Yours sincerely,  
For and on behalf of  
Versitech Ltd

Annie Kong  
Assistant Finance Manager  
Enc.

Ex. D

**From:** "Bryan M.H. PONG" <mhp@eee.hku.hk>  
**To:** "Hua Gao" <gaoh@pennie.com>  
**Date:** Thu, Nov 1, 2001 5:31 AM  
**Subject:** Fw: Draft Patent application: your Ref.# IP00061; our matternumber 24\_999

----- Original Message -----

From: "Bryan M.H. PONG" <mhp@eee.hku.hk>  
To: "Bryan M.H. PONG" <mhp@eee.hku.hk>  
Sent: Thursday, November 01, 2001 6:30 PM  
Subject: Re: Draft Patent application: your Ref.# IP00061; our matternumber 24\_999

> Dear Shirley,  
> Please find the attached document. I have marked up my replies in the  
> specification file and the diagram files. I have also provided an  
additional  
> file corresponding to the changes.  
>  
> Please progress with the filing process.  
>  
> Regards  
> Bryan Pong  
>  
>

> ----- Original Message -----

> From: "Bryan M.H. PONG" <mhp@eee.hku.hk>  
> To: "Shirley Yu" <shirley@versitech.hku.hk>  
> Sent: Saturday, October 06, 2001 2:58 PM  
> Subject: Re: Draft Patent application: your Ref.# IP00061; our  
matternumber  
> 24\_999  
>  
>  
>

>> Dear Shirley,  
>> I shall respond in around 2 week's time.  
>>  
>> Also please give me a summary of the status of our patents.

>>  
>> Regards  
>> Bryan

>> ----- Original Message -----

>> From: "Shirley Yu" <shirley@versitech.hku.hk>  
>> To: "Dr. Bryan M.H. Pong" <mhp@eee.hku.hk>  
>> Sent: Friday, October 05, 2001 3:47 PM  
>> Subject: Fw: Draft Patent application: your Ref.# IP00061; our  
matternumber  
>> 24\_999  
>>  
>>

>>> Dear Bryan,

>>>

>>> I refer to the above and attach a copy of the draft patent application  
> for

>>> your review and comments. The password is "9661".

9661-0



>>>  
>>> I look forward to hearing from you soon.  
>>>  
>>> Regards,  
>>> Shirley Yu  
>>> Legal Officer  
>>> Versitech Ltd  
>>>  
>>>  
>>>  
>>> ----- Original Message -----  
>>> From: "Rattan Nath" <Nathr@PENNIE.COM>  
>>> To: <Shirley@versitech.hku.hk>  
>>> Cc: <gaoh@PENNIE.COM>; <Millerc@PENNIE.COM>  
>>> Sent: Wednesday, October 03, 2001 12:34 AM  
>>> Subject: Draft Patent application: your Ref.# IP00061; our  
matternumber  
>>> 24\_999  
>>>  
>>>  
>>> Dear Shirley,  
>>>  
>>> I am sending you a copy of the draft patent application in PDF  
> format.  
>>> Please forward it to the inventors for their comments. I have  
included  
>> two  
>>> questions for the inventors to better define the scope of the  
invention.  
>>> The questions are set apart by square brackets and are in bold. If  
>>> possible, I would like the inventors to respond to them.  
>>>  
>>> I look forward to hearing from you and the inventors. Thank you.  
>>>  
>>> Best regards.  
>>>  
>>> Rattan Nath  
>>>  
>>>  
>>>  
>>> \*\*\*\*\*  
>>> THIS ELECTRONIC MAIL MESSAGE AND ANY ATTACHMENT IS  
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>>> sender to notify us of the error and delete the original  
>>> message. Thank You.  
>>> \*\*\*\*\*

>>>  
>>>  
>>  
>

Ex.E

# PENNIE & EDMONDS LLP

CALIFORNIA OFFICE  
3300 HILLVIEW AVENUE  
PALO ALTO, CALIFORNIA 94304  
(650) 493-4935  
FACSIMILE: (650) 493-5556

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FACSIMILE: (212) 869-9741/8864  
MCI MAIL: 561-3768

WASHINGTON OFFICE  
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(202) 496-4400  
FACSIMILE: (202) 496-4444

WRITER'S DIRECT DIAL:  
(212) 790-6586

INTERNET ADDRESS:  
GAOH@PENNIE.COM

November 29, 2001

By Facsimile; Original By Airmail  
(011) 852-2299-0122

Y/R: IP00061  
O/R: 9661-0024

Ms. Shirley Yu  
Legal Officer  
VERSITECH LTD.  
First Floor, Technology Innovation and Incubation Building  
THE UNIVERSITY OF HONG KONG  
Pokfulam Road  
HONG KONG

Re: New U.S. Patent Application  
For: High Efficiency Driver for Color Light  
Emitting Diodes (LED)  
Inventors/Applicants: Pong et al.  
Assignee: The University of Hong Kong

Dear Shirley:

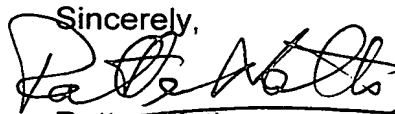
In connection with the filing of the above-identified application, I have enclosed the following documents for execution: (i) Declaration for Non-Provisional Patent Application; (ii) Assignment; and (iii) Power of Attorney by Assignee. Please examine the documents, and if all the information in the forms are correct, have the inventors (execute) sign and date the Declaration and Assignment, and have Mr. Yu execute the Power of Attorney.

We strongly recommend that the Assignment be signed in the presence of a witness. Upon receiving the executed documents, I will file them together with the application.

I sincerely appreciate your confidence in entrusting this matter to our attention and care.

Best regards.

Sincerely,

  
Rattan Nath

Enclosures (by air mail)  
c: Charles E. Miller, Esq.  
Hua Gao, Patent Agent

## ASSIGNMENT

JOINT

WHEREAS, WE, (i) Man Hay Pong; (ii) Franki Ngai Kit Poon; and (iii) Joe Chui Pong LIU, ASSIGNORS, citizens of CHINA, residing at (i) Flat G, 1<sup>st</sup> Floor, Tower 13A, Yee Fai Court, South Horizons, Ap Lei Chau, Hong Kong; (ii) 1<sup>st</sup> Floor, 312, Ki Lung Street, Sham Shui Po, Kowloon, Hong Kong; and (iii) Flat 3406, Kwai Fung House, Kwai Chung, New Territories, Hong Kong, respectively, are the inventors of the invention in **HIGH EFFICIENCY DRIVER FOR COLOR LIGHT EMITTING DIODES (LED)** for which we have executed an application for a Patent of the United States

- ☒ which is executed on ☐ even date herewith or ☐ \_\_\_\_\_  
☒ which is identified by Pennie & Edmonds LLP docket no. 9661-0024  
☐ which was filed on as Patent Application No. \_\_\_\_\_

and WHEREAS, The University of Hong Kong, ASSIGNEE, having a place of business at Pokfulam Road, Hong Kong, China, is desirous of obtaining our entire right, title and interest in, to and under the said invention and the said application:

NOW, THEREFORE, in consideration of the sum of One Dollar (\$1.00) to us in hand paid, and other good and valuable consideration, the receipt of which is hereby acknowledged, we, the said ASSIGNORS, have sold, assigned, transferred and set over, and by these presents do hereby sell, assign, transfer and set over, unto the said ASSIGNEE, its successors, legal representatives and assigns, our entire right, title and interest in, to and under the said invention, and the said United States application and all divisions, renewals and continuations thereof, and all Patents of the United States which may be granted thereon and all reissues and extensions thereof; and all applications for industrial property protection, including, without limitation, all applications for patents, utility models, and designs which may hereafter be filed for said invention in any country or countries foreign to the United States, together with the right to file such applications and the right to claim for the same the priority rights derived from said United States application under the Patent Laws of the United States, the International Convention for the Protection of Industrial Property, or any other international agreement or the domestic laws of the country in which any such application is filed, as may be applicable; and all forms of industrial property protection, including, without limitation, patents, utility models, inventors' certificates and designs which may be granted for said invention in any country or countries foreign to the United States and all extensions, renewals and reissues thereof;

AND WE HEREBY authorize and request the Commissioner of Patents and Trademarks of the United States, and any Official of any country or countries foreign to the United States, whose duty it is to issue patents or other evidence or forms of industrial property protection on applications as aforesaid, to issue the same to the said ASSIGNEE, its successors, legal representatives and assigns, in accordance with the terms of this instrument.

AND WE HEREBY covenant and agree that we have full right to convey the entire interest herein assigned, and that we have not executed, and will not execute, any agreement in conflict herewith.

AND WE HEREBY further covenant and agree that we will communicate to the said ASSIGNEE, its successors, legal representatives and assigns, any facts known to us respecting said invention, and testify in any legal proceeding, sign all lawful papers, execute all divisional, continuing, reissue and foreign applications, make all rightful oaths, and generally do everything possible to aid the said ASSIGNEE, its successors, legal representatives and assigns, to obtain and enforce proper protection for said invention in all countries.

IN TESTIMONY WHEREOF, We hereunto set our hands and seals the day and year set opposite our respective signatures.

Date 10 Dec, 2001 Man Hay Pong L.S.

WITNESS:

Slaw

Date 10 Dec, 2001 Franki Ngai Kit Poon L.S.

WITNESS:

Slaw

Date 10 Dec, 2001 Joe Chui Pong Liu L.S.

WITNESS:

Slaw



**ERSITECH LTD.**

The University technology transfer company



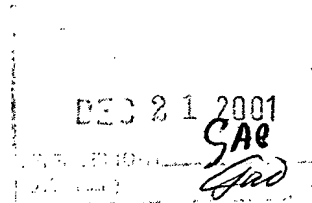
Ex. 6

Our Ref.: IP00061

Your Ref.: --

December 12, 2001

Ms. Hua Gao  
Pennie & Edmonds LLP  
1155 Avenue of the Americas  
New York, NY 10036-2711  
U.S.A.



By Fax No.: 1 212 869 9741

Pages: 4

Confirmation By Post

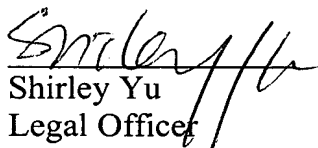
Dear Hua,

**Re: US Non-Provisional Application – High Efficiency Driver for Color Light Emitting Diodes (LED)**

I refer to the above and enclose the executed Declaration and Assignment for your action.

Thank you for your assistance in this matter.

Yours sincerely,

  
Shirley Yu  
Legal Officer

Enc.